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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,599	10/16/2001	Rony A. Abovitz	ZKT 2 0014	5128

7590 01/31/2005

Thomas E. Kocovsky, Jr.  
FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP  
Seventh Floor  
1100 Superior Avenue  
Cleveland, OH 44114-2518

EXAMINER
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JUNG, WILLIAM C

ART UNIT	PAPER NUMBER
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3737

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/978,599

Applicant(s)

ABOVITZ ET AL.

Examiner

William Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-15 and 17-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-15 and 17-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because the length of the abstract is over 15 lines or 150 words. Correction is required. See MPEP § 608.01(b).

### *Response to Arguments*

2. Applicant's arguments with respect to claims 2-15 and 17-39 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-15 and 17-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Kienzle, III et al* (US 6,285,902) in view of *Martinez* (US 4,577,629).

Kienzle, III et al substantially disclose all claimed features in claims 2-15 and 17-39.

**Claims 2, 5, 7-11, 20, 23, 30, 31, 38, and 39:** Kienzle, III et al disclose a method and apparatus where an imaging guided surgery system with computer includes an image guided surgery software that provides an minimal user functionality by having specific software enabled to apply preselected surgical procedure and software-integrated kit for instrumented tools and digital medium with image guided surgery software to facilitate the performance of the surgical procedure and a tracking system to locate the surgical tools via display used in conjunction with the computer (col. 4, line 16 – col. 5, line 13; col. 6, lines 25-35; col. 8, line 14 – col. 9, line 44).

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However, Kienzle, III et al do not disclose that the surgical tools are disposable kit. It is well known in the art that the surgical tools or instruments are disposable for safety reason where the tools are discarded to disposed until the tools are sterilized as shown by Martinez for example. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply the teachings of Martinez's disposable surgical tools to the method and system of Kienzle, III et al described above.

***Claims 3, 4, 6, 12-15, 17-19, 21, 23, 24-29, and 32-37:*** Kienzle, III et al disclose a mobile cart 125 that holds computer 121, 124 and display 122 which receive and display digital data obtained from the imaging unit 112 as shown in figure 1. In addition, the image-guided system includes position-monitoring sensor 123 tracking the position and movement of the surgical tools. Furthermore, Kienzle, III et al disclose image mapping of the where image guidance is referenced from the image coordinate correlated to position sensor and tracking device (col. 11, line 31 – col. 12, line 20).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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January 9, 2005

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700